

REMARKS

Applicant has carefully reviewed in light of the Office Action mailed April 26, 2006. Claims 1 and 15 have been cancelled without prejudice or disclaimer. Claims 2-14 and 16-20 are pending in this Application. Claims 5-7, 10, 11 and 14 stand rejected under 35 U.S.C. § 112.

Claims 1-3, 6, 7 and 15-18 stand rejected under 35 U.S.C. § 102(b), and Claims 4, 5, 8-14, 19 and 20 stand rejected under 35 U.S.C. § 103. Claims 2-11, 14 and 16-20 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 5-7, 10, 11 and 14 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner alleges that Claim 5 is indefinite, asserting that it is unclear whether the term "magnetic switch" is the same "magnetic switch" disclosed in Claim 3. Applicant respectfully submits that the rejection of Claim 5 under Section 112 is improper. It is well-established that if a claim term appears in more than one claim, such term shall be construed the same in each. *See, e.g., CVI/Beta Ventures, Inc. v. Tura L.P.*, 112 F.3d 1146, 1159 (Fed. Cir. 1997). Thus, Applicant submits that according to the standard set forth by the Federal Circuit, the term "magnetic switch" recited in Claim 5 is to be construed the same as in Claim 3. Accordingly, the term "magnetic switch" recited in Claim 5 is not indefinite, and the rejection of Claim 5 under 35 U.S.C. § 112 is improper.

With respect to the rejections of Claims 6, 7, 10, 11 and 14 as being indefinite under 35 U.S.C. § 112, Applicant has amended Claims 6, 7, 10, 11 and 14 to overcome these rejections.

For at least the reasons discussed above, Applicant respectfully requests reconsideration, withdrawal of the rejections under 35 U.S.C. § 112 and full allowance of Claims 5-7, 10, 11 and 14.

Rejections under 35 U.S.C. § 102

Claims 1-3, 6, 7 and 15-18 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0103616 by Ilwhan Park et al. ("*Park*"). With respect to Claims 1 and 15, the Applicant has cancelled Claims 1 and 15, thus rendering the rejections of such Claims moot.

Although Applicant makes no concessions regarding the rejections of Claims 2, 3, 6, 7, and 16-18, Applicant believes that: (i) Claims 2, 3, 6 and 7 are allowable at least because they depend from and provide further patentable limitations of Claim 4 shown to be allowable below, and (ii) Claims 16-18 are allowable at least because they depend from and provide further patentable limitations of Claim 20 shown to be allowable below. Therefore, Applicant respectfully submits that the Examiner reconsider, withdraw the rejections under 35 U.S.C. § 102(b) and allow Claims 2, 3, 6, 7 and 16-18.

Rejections under 35 U.S.C. § 103

Claims 4, 5 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park*.

Claims 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* as applied to Claim 1 above, and further in view of U.S. Patent No. 6,114,958 issued to Stephen C. Murphy ("*Murphy*").

Claims 9-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* as applied to Claims 1-3, 6 and 7 above, and further in view of U.S. Patent No. 6,473,076 issued to Curtis D. Thompson et al. ("*Thompson*").

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Park* and *Thompson*, and further in view of *Murphy*, as applied to Claims 8 and 9 above.

Park discloses a system and method for activating and deactivating touch screen components of a hand-held device by detecting whether a stylus associated with the touch screen is present in, or has been removed from, a stylus receiving receptacle, such as a stylus slot. (Paragraph [0005]).

Thompson discloses a method and apparatus for controlling the power of a handheld computing device with a stylus. (Col. 2, lines 14-16). An elongated slot for holding a stylus

includes a switch that when activated, transitions the handheld computing device from an “on” state to an “off” state and vice versa. (Col. 3, lines 50-53).

Claim 4, as amended, recites an information handling system comprising “a power supply maintained by [a] stylus ... the stylus and [a] stylus garage cooperating to disengage the stylus power supply when the stylus is parked in the garage.”

Claim 9, as amended, discloses software operable to “disengage a power supply maintained by the stylus when the stylus is parked in the garage.”

Claim 20, as amended, recites a method for powering an information handling system comprising disengaging “a stylus power supply while the stylus is parked in the stylus garage.”

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant respectfully submit that the cited references fail to disclose every element of Applicant’s invention as amended. Further, there is no motivation, teaching, or suggestion to combine *Park* and *Thompson*.

Regarding Claims 4 and 20, *Park* fails to teach, disclose or suggest an information handling system comprising a “a power supply maintained by [a] stylus ... the stylus and [a] stylus garage cooperating to disengage the stylus power supply when the stylus is parked in the garage,” as recited by amended Claim 4 and a method for powering an information handling system comprising disengaging “a stylus power supply while the stylus is parked in the stylus garage,” as recited in amended Claim 20. In supporting the rejection of Claims 4 and 20, the Examiner states that:

... it would have been obvious to one of ordinary skill in the art that a stylus having its own power supply has the ability to disengage the power supply when the stylus is parked in a stylus garage. When parked in the stylus garage, the stylus is in an idle state and is not used, therefore, it would be obvious to at least place the stylus in a reduced power consumption setting.

(Office Action, Page 5).

The Examiner's rejection of Claims 4 and 20 is incorrect for a number of reasons. First, even assuming, *arguendo*, that it would have been obvious to one of ordinary skill in the art that a stylus having its own power supply could be disengaged when the stylus is parked in a stylus garage (which Applicant does not concede), the Examiner has failed to assert that *Park* discloses, teaches or suggest a stylus having its own power supply, presumably because *Park* does not support such a statement. In fact, only by reading Applicant's Specification can a person of skill in the art recognize the utility of including a power supply in a stylus wherein the "stylus power supply is disengaged when the stylus is parked in the garage." It is improper to use Applicant's Specification as evidence that a claim element is well known in the art. Accordingly, *Park* fails to disclose, teach or suggest the recited limitations, and therefore, cannot anticipate Claims 4 and 20.

Furthermore, the Examiner has failed to provide proof (*e.g.*, references of record) to support the conclusions that it would have been obvious to include a power supply in a stylus or that "it would have been obvious to one of ordinary skill in the art that a stylus having its own power supply has the ability to disengage the power supply when the stylus is parked in a stylus garage." (Office Action, Page 6). If the Examiner is relying upon personal knowledge to support such a conclusion, no affidavit has been provided in accordance with the M.P.E.P. See M.P.E.P. § 2144.03 (setting forth the requirements of reliance of common knowledge in the art). For at least these reasons, the Examiner's rejection of Claims 4 and 20 under 35 U.S.C. § 103(a) is improper.

Regarding Claim 9, *Park* and *Thompson*, alone or in combination, fail to disclose, teach or suggest software operable to "disengage a power supply maintained by the stylus when the stylus is parked in the garage," as recited by amended Claim 9. In particular, for the same or analogous reasons to those set forth above with respect to Claims 4 and 20, the references cited by the Examiner fail to disclose, teach or suggest a power supply maintained

by a stylus, much less a stylus power supply that is disengaged when a stylus is parked in a stylus garage. Accordingly, *Park* and *Thompson* fail to disclose, teach or suggest the recited limitations, and therefore, cannot anticipate Claims 9.

Given that Claims 5 and 8 depend from Claim 4, Claims 10-14 depend from Claim 9, and Claim 19 depends from Claim 20, Applicant respectfully submits that Claims 5, 8, 10-14 and 19 are allowable. As such, Applicant respectfully requests that the Examiner withdraw the rejections and allow Claims 4, 5, 8-14, 19 and 20.

CONCLUSION

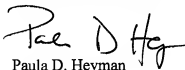
Applicant appreciates the Examiner's careful review of the application. Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicant respectfully requests reconsideration of the rejections and full allowance of Claims 2-14 and 16-20.

Applicant believes no fees are due at this time, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2581.

Respectfully submitted,

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